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IN THE

Supreme Court of the United States

October Term, 1968

Docket No. 1249

JOHN K. RAINS,

Petitioner,

against

NIAQUA, INC.,

Respondent.

BRIEF IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI

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INDEX.

	PAGE
Opinions Below	1
Questions Presented Criticized	2
Statement of the Case Inaccuracies	3
Argument	3
Conclusion	7

TABLE OF CASES.

Graham v. John Deere Co., 383 U. S. 1 (1966)	4
John K. Rains v. Cascade Industries, Inc., 402 F2d 241 (3rd Cir. 1968)	1, 3, 6
Pavement Salvage Company, Inc. v. Andersons Black Rock, Inc., 404 F2d 450 (4th Cir. 1968), certiorari granted March 25, 1969	5

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Respondent, Niaqua, Inc., defendant below, respectfully requests that the Petition For A Writ Of Certiorari filed herein be denied.

Opinions Below

In Petitioner's statement (Page 2) with respect to the case of *John K. Rains v. Cascade Industries, Inc.*, 402 F2d 241 (3rd Cir. 1968) (A18), it states that there is presented a conflict in decisions on the same patent between the Third Circuit and the Second Circuit.

The Third Circuit, by a divided court reversed a summary judgment of the District Court which had held the

Rains patent invalid without a trial, and remanded the case to the District Court for further proceedings. The Second Circuit in the instant case sustained the District Court's decision of invalidity of the Rains patent, which decision was rendered after a three day plenary trial, and after the consideration of briefs. It is submitted that there is no conflict between the Circuits. The Third Circuit has said that the validity or invalidity of the Rains patent should not have been determined without a trial in the District Court; whereas the Second Circuit has sustained the invalidity of the Rains patent decided after a full trial had been held in the District Court.

Questions Presented Criticized

Petitioner's Question 1. fails to refer to the extensive cross-examination of plaintiff Rains, and the acute questioning of Rains by the Trial Judge, all of which resulted in explanations of the prior art and admissions by Rains of the pertinency of the prior art. The question also fails to refer to the fact that the examination of plaintiff's other witnesses did not establish their background knowledge of the prior art so as to qualify them to testify as experts on nonobviousness; and that cross-examination of witnesses established the public acceptance of other competitive above ground pools in recent years.

Petitioner's Questions 2. and 3. are subject to the same defects as pointed out herein with respect to Petitioner's Question 1. Petitioner in effect tries to claim that the testimony adduced by the examination and cross-examination of plaintiff's witnesses cannot be used by defendant and the courts to evaluate the prior art; but that defendant should have duplicated such testimony by its own witnesses.

Statement of the Case Inaccuracies

The Petition states (page 4); "The defendant presented no evidence, having rested at the conclusion of the plaintiff's case." Petitioner's statement is incorrect, as defendant's evidence consists of a number of exhibits, as well as the testimony given during the examination and cross-examination of plaintiff and a number of plaintiff's witnesses.

The Petition (pages 5, 8 and 9), in a number of instances refers to alleged "unevaluated prior art"; one example of evaluation of prior art is found in the Second Circuit's Opinion where it states (A10); "But here, when the very similar features of the French patent—the cross-sectional drawing there and the cross section figure included in plaintiff's patent are, as plaintiff admitted at trial, virtually identical—are considered, plaintiff's design is seen to be a mere adaptation of these features to the similar redwood type pools of the prior art." There were many more instances of evaluation of the prior art.

Argument

Contrary to the argument of Petitioner, the decision of the Second Circuit Court of Appeals in the instant case (A1) is not in direct conflict with the opinion of the Third Circuit Court of Appeals in *Rains v. Cascade Industries, Inc.* (A18). In the instant case the Second Circuit Court of Appeals has held the Rains patent to be invalid; affirming the decision of the District Court which was made after a full plenary trial in the District Court, and after evaluating the testimony of witnesses and considering all the evidence; while the Third Circuit Court of Appeals in the *Cascade* case has merely reversed a decision made on summary judg-

ment by its District Court, and remanded that case for further proceedings.

The Second Circuit Court of Appeals has not decided an important federal question in conflict with *Graham v. John Deere Co.*, 383 U. S. 1 (1966) as argued by Petitioner; on the contrary, the court stated (A8); "In comparing plaintiff's design with prior art, we are aided by the guide laid down by the Supreme Court in *Graham v. John Deere Co.*, * * *".

Petitioner further argues that the Second Circuit Court of Appeals has ignored the statutory presumption of validity of a patent; but the court clearly recognized that presumption (A6-7), and held that it had been overcome by the evidence, including the admissions of the plaintiff himself at the trial with particular respect to the similarity of the French patent (A9-10).

That the prior art was unevaluated, unexplained and uninterpreted as argued by Petitioner, is entirely contrary to the fact. Defendant could have, and was prepared at the trial to produce witnesses to testify with respect to the prior art; but after having the plaintiff, the patentee himself, fully discuss the prior art, and make important admissions as to similarities, it was decided that no duplication of such testimony by defendant's witnesses would be necessary. The testimony of defense offered witnesses could not possibly have had the weight that the admissions against his own interests, made by the plaintiff—patentee himself had. The prior art was identified, evaluated, explained and interpreted by the plaintiff—patentee himself on cross-examination and by questions from the Trial Judge.

Not one of plaintiff's witnesses who testified on non-obviousness, stated that he was familiar with all the prior art in evidence including the French patent (A7 footnote[3]). Therefore, such testimony was ineffective.

The secondary factor of alleged long felt need and commercial success has been stressed in this case by plaintiff; but again, cross-examination of plaintiff's witnesses resulted in the following finding by the Second Circuit Court of Appeals (A10-11): "The evidence is not so clear as plaintiff claims, however, as there was evidence that all types of above ground swimming pools, including competing designs, were enjoying greatly increasing sales so that social and economic factors may have been a major reason for commercial success."

Petitioner's argument that the instant case, and that of *Pavement Salvage Company, Inc. v. Andersons Black Rock, Inc.*, 404 F2d 450 (4th Cir. 1968), certiorari granted March 25, 1969, are in any way comparable in without merit. There are no important federal issues involved in the instant case.

The Petition herein makes no reference whatsoever to the gussets which are a part of the Rains patented design, and these gussets are shown as plates which partially enclose the triangular supports for, and below the walkway (A35, A39, and A40). The reason for the lack of discussion of the gussets is that defendant here never used them (A8 footnote and A17). Therefore, in the instant case plaintiff has taken the position that the gussets are not an essential part of the alleged patented invention; and so, in the instant case, the prior art need not show gussets for consideration of invalidity.

The consideration and decision of the Third Circuit in the *Cascade* case however, is replete with reference to gussets as follows (A20): "The struts, studs and deck form an open triangle which is covered by gussets which fill the open triangle except for a small space at its top and bottom" * * *. "Another variation is a larger version of the first design, with additional struts, studs and gussets." * * * "A drawing for the French Patent No. 768,506 * * * discloses an on-the-ground pool * * * but with no gussets." Referring to the design patent to Pruess in 1961 the court stated (A21): "There are no gussets." The court further stated (A24): "The prior art shows that plaintiff's design at least differed from it in utilizing the gussets * * *"; and (A27) "Moreover, in the prior art no gussets were used for support."

A patentee cannot take the position, that for purposes of charging infringement as in the instant case, his patent can be broadened by disregarding an apparent limitation therein (the ornamental gussets), and at the same time take the position that prior art which does not show the disregarded limitation (the ornamental gussets) will not invalidate his patent as so broadened.

The factual and legal posture of the instant case clearly distinguishes it from the *Cascade* case, wherein "gussets" have been held to be an important factor.

Conclusion

This is the usual patent case; no great public interest or Federal questions are involved; there is no conflict wherein one Circuit Court has held a patent to be invalid and a different Circuit Court has held the same patent to be valid. The Petition for a Writ of Certiorari should be denied.

Dated: May , 1969.

Respectfuly submitted,

EDWIN T. BEAN,
Attorney for Respondent.